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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/542,564 10/13/95 MINOR

H	A-62506/MSB
EXAMINER	

GREGORY, B

ART UNIT	PAPER NUMBER
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22M2/0918
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FOUR EMBARCADERO CENTER
SAN FRANCISCO CA 94111

2202
DATE MAILED:

09/18/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☒ COMPUTER INVENTION FLOWCHART

Part II SUMMARY OF ACTION

1. ☒ Claims 1-21 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☒ Claims 1-2 + 14-15 are allowed.

4. ☒ Claims 3-13 + 16-21 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit: 2202

1. Claims 1-2 and 14-15 are allowable over the prior art of record.
2. Claims 3-13 and 16-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout claims 3-13 and 16-21, each and every use of a form of either "encode" or "decode" is unclear and incorrect. The processes in view that are described using forms of either "encode" or "decode" are actually encrypting and decrypting respectively. Correction is hereby required. Throughout claims 11-12, the uses of "hot spot" and "reply page" are unclear. In independent claim 18, the uses of "can" are indefinite and unclear. Dependent claims 4-6, 8-10, 12-13, and 19-21 are unclear in that they depend from unclear claims 3, 7, 11, and 18.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

4. Claims 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Art Unit: 2202

The analysis used in this rejection is made according to the final version of the "Examination Guidelines for Computer-Related Inventions," 61 Fed. Reg. 7478 (Feb. 28, 1996), reprinted in 1184 O.G. 87 (March 26, 1996). The flowchart of the Guidelines is used in this rejection, and a copy of the flowchart is included herewith for Applicants' convenience. Since the software in the "computer readable memory" of claims 18-21 has not been claimed so as to definitely be able to control a machine, it can not be said to be a specific machine or manufacture, even though it is a product for performing a process. This is so because line 1 of independent claim 18 says "can be used", merely offering potential to control a computer. In addition, section IV.B.2.(a)(ii) of the Guidelines say that claims must "define a computer-related invention" in terms of "its hardware or hardware and 'specific software'." In a footnote, "specific software" is defined as "a set of instructions implemented in a specific program code segment." Plainly, claims 18-21 are not so drafted. Thus, claims 18-21 do not claim a specific machine or manufacture. Please see section IV.B.2.(a)(i) through section IV.B.2.(a)(ii) of the Guidelines.

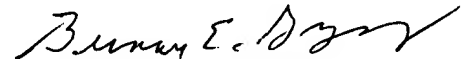
Art Unit: 2202

Since the claim language does not claim that the software in the computer readable memory does direct or control the computer (the potential word "can" is used at the beginning of claim 18), claims 18-21 must take a NO at box 12 of the flowchart and a YES at box 13 of the flowchart. Therefore, claims 18-21 are non-statutory.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aziz (U.S. Patent 5,416,842) is of general interest for showing data security in Internet.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernarr Gregory whose telephone number is (703) 306-4153 and whose FAX number is (703) 306-4195.


BERNARR E. GREGORY
PRIMARY EXAMINER
GROUP 2200

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September 14, 1996